

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 14364US08)

In The Application Of:)
Joseph J. Kubler, *et al.*)
Serial No.: 10/783,587)
Filed: February 20, 2004)
For: HIERARCHICAL DATA COLLECTION) Filed electronically on
NETWORK SUPPORTING) November 11, 2010.
PACKETIZED VOICE)
COMMUNICATIONS AMONG)
WIRELESS TERMINALS AND)
TELEPHONES)
Examiner BARON, HENRY)
Group Art Unit: 2462)
Confirmation No.: 7711)

PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application (the "Application"). No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: November 11, 2010

By: /Kevin E. Borg/
Kevin E. Borg
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REMARKS

The Application includes pending claims 22, 23, 25-39, 41-66, 68-83, 85-103, and 105-122, all of which have been rejected. Applicants respectfully submit that the claims define patentable subject matter.

Claims 22, 23, 25-31, 38, 39, 41-50, 61-66, 68-74, 81-83, 85-94, 102, 103, and 105-114 were rejected under 35 U.S.C. §103(a) as being unpatentable over Norman, *et al.* (US 5,737,328, "Norman"), in view of Chu, *et al.* (US 5,890,055, "Chu"), in further view of Capps (US 7,086,008). Claims 34-36, 53-57, 59-60, 77-79, 97-101, and 117-121 were rejected under 35 U.S.C. §103(a) as being unpatentable over Norman and Chu, in view of Wadin (US 5,491,739), in further view of Capps. Claims 32, 33, 37, 51-52, 58, 75-76, 80, 95, 96, 115, and 116 were rejected under 35 U.S.C. §103(a) as being unpatentable over Norman, in view of Chu, in view of Spiegel , *et al.* (US 5,649,108, "Spiegel") and in further view of Capps. The Applicants respectfully traverse the rejections for at least the following reasons.

Applicants respectfully submit that independent claim 22 recites "[a] method of operating a communication system, the method comprising: sending, by a first terminal via a communication link, a message requesting routing of a call from the first terminal to a second terminal; receiving, by the first terminal via the communication link, a message comprising call routing information identifying call routes through a network; selecting, at the first terminal, a call route based upon the call routing information, the selecting comprising providing a user of the first terminal with call routing options using the call routing information, and receiving from the user of the first terminal an indication of a selected call route; and transmitting, by the first terminal via the communication link, a message requesting setup of the call from the first terminal to the second terminal using the selected call route." Independent claims 38, 58, 65, 82, and 102 recite similar features, and are rejected over the same art and with similar rationale set forth in the rejection of claims 22 and 65. Applicants respectfully submit that the Office has not met its burden in establishing a *prima facie* case of obviousness with respect to claims 22, 38, 58, 65, 82, and 102, or any claims that depend therefrom, for at least the reasons set forth below and during prosecution.

Initially, Applicants respectfully submit that the Office interprets the teachings of the cited art inconsistently, ignores aspects of the claims, and fails to show the support needed to establish a *prima facie* case of obvious as required by M.P.E.P. §2142.

For example, with regard to the feature of claim 22 that recites, "sending, by a first terminal via a communication link, a message requesting routing of a call from the first terminal to a second terminal," the Office identifies receiving by an "access point" of Norman as teaching Applicants claimed "sending," suggesting that the Office is asserting that the "mobile unit," not the "access point" of Norman, teaches Applicants' claimed "first terminal." See July 6, 2010 Response at page 24. The Office, although solicited by the Applicants, did not identify error in Applicants' stated interpretation of the arguments of the Office, stating only "Examiner replies that the claim asserts and [sic] a first terminal and a second terminal, and in a broad interpretation, an access unit and mobile unit can be so defined." See August 31, 2010 Office action at page 2.

At pages 27-29, however, the Office identifies Applicants' claim 22 feature receiving, by the first terminal via the communication link, a message comprising call routing information identifying call routes though a network," as being performed by the "access point" of Norman and, therefore, that the Office asserts that the "access point" of Norman teaches Applicants' claimed "first terminal," contrary to the earlier assertion by the Office, discussed above, that Applicants' claimed "first terminal" is taught by the "mobile unit" of Norman. Although solicited by the Applicants, the Office again did not identify error in Applicants' stated understanding of the rejection and interpretation of the cited art. Instead of addressing the substance of Applicants' arguments, as required by M.P.E.P. §707.07(f), the Office simply stated, "Examiner replies that as the claim calls for a first and second terminal, then an embodiment of such terminals can be a mobile unit or base station. Examiner broadly interprets first and second terminal." See August 31, 2010 Office action at page 4. Applicants respectfully submit that the Office must show support per M.P.E.P. §2142 for all interpretations of the art. Applicants respectfully submit that such inconsistency in interpretation of the alleged teachings, failure to address the substance of Applicants' arguments, and vague, broad interpretations with support, are each a failure to meet the requirements of M.P.E.P. §2142 in establishing a *prima facie* case of obviousness, and **amount to clear error**.

In rejecting the feature of claim 22 that recites, *inter alia*, "receiving, by the first terminal ... a message comprising call routing information identifying call routes through a network," the Office cites Norman beginning at col. 16, line 61, which relates to the determination by an "access point" whether a "find router packet" has been received from a "mobile unit." See August 31, 2010 Office action at page 5. Applicants respectfully submit that the Office fails to show that Norman teaches that the "find router packet" from the "mobile unit" or the "router identification" response from the "access point" of Norman comprise a "call route" through a network." Instead, Norman discloses that the "find router packet" includes "information indicating to any access points which are within receiving range of the broadcast that the particular mobile unit is seeking to register with an access point," while the "router identification" response includes "information as to the identity of the access point, the amount of use (or "load") on the access point, and an indication of the relative location of the access point in the network 32." See *id.* at col. 15, lines 47-57. Applicants respectfully submit that the "find router packet" and "router identification" response disclose, at most, information identifying the "mobile unit" or the "access point" and the "relative location of the access point in the network," which does not teach, suggest or disclose "information identifying call routes through a network," as claimed. Therefore, Applicants respectfully submit that such an interpretation of the art, **amounts to clear error**.

In rejecting Applicants' claim 22 feature "selecting, at the first terminal, a call route based upon the call routing information, the selecting comprising providing a user of the first terminal with call routing options using the call routing information, and receiving from the user of the first terminal an indication of a selected call route," the Office again cites teachings of Norman relating to the "access point" (See August 31, 2010 Office action at pages 5-6), although the Office earlier identified the "mobile unit" of Norman as teaching Applicants' "first terminal."

The Office admits that Norman does not disclose "providing a user of the first terminal with call routing options using the call routing information" and "receiving from the user of the first terminal an indication of a selected call route," but asserts that Capps teaches the missing subject matter. See August 31, 2010 Office action at pages 6-7. Applicants demonstrate that Capps teaches "printing," "faxing," "beaming,"

"duplicating," and "deleting" actions for handling a "note document," and that such "actions" related to a "note document" are quite different from and do not teach or suggest "routing information [identifying call routes though a network]" for a "call." See July 6, 2010 response at pages 31-32. Applicants respectfully submit that the identification and assertion that such "actions" taught by Capps teach, suggest, or disclose "call routing options," in the context of Applicants' claim 22, **amounts to clear error.**

In addition, the Office admits that Norman does not teach, at least, "...where a message requests routing of a call; selecting a call route; or requesting setup of the call," and then asserts that Chu teaches the missing subject matter. *See* August 31, 2010 Office action at page 6. Applicants demonstrate that the cited portion of Chu fails to explicitly disclose any messages, let alone the alleged teaching of "where a message requests routing of a call; selecting a call route; or requesting setup of the call" in the context of claim 22, and that the Office has failed to provide any support for perceived assertions of either inherency or Official Notice. *See* July 6, 2010 response at pages 25-27. In the Office action of August 31, 2010, the Office again fails to respond to the substance of Applicants' arguments (as required by M.P.E.P. §707.07(f)), and simply states that "Examiner replies that Chu may not use the precise terminology of the claim, but as cited below teaches the limitation e.g. 'perform call setup and switching functions' can be interpreted as requesting routing for a call and selecting a route." *See* August 31, 2010 Office action at page 3. Applicants respectfully note that although the Office asserts such an interpretation is possible, such a response without the required "explicit analysis" does not allow the Board of Patent Appeals and Interferences, or the courts, to review the reasoning of the Examiner and the cited support in the art used as basis for the rejection. Further, Applicants respectfully submit that the bare teaching of the Chu cannot be stretched so far as to disclose what is alleged, and that asserting that any portion of Chu teaches these aspects admittedly missing from Norman without the support required by M.P.E.P. §2142 simply **amounts to clear error.**

Applicants respectfully submit that the errors discussed above apply to independent claims 38, 58, 65, 82, and 102, and their respective dependent claims, as well.

In addition, Applicants respectfully note that the Response to Arguments of August 31, 2010 states, in part, “[w]ith regard to independent claim 22, Applicants submits that claim 22 has been amended to include the features of dependent claim 24, so that claim 22 now recites” *See id.* at page 3. Applicants respectfully submit that the response of July 6, 2010, to which the Office responds, **does not state that claim 22 has been amended, but instead clearly states that “[n]o claims are amended by this response.”** *See* July 6, 2010 response at page 27. Applicants wonder what document the Office examined. Further, the Office action of August 31, 2010 states at page 16, in part, “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL.” Applicants again respectfully point out that **no claim amendments were made in the response of July 6, 2010.** Applicants respectfully submit that these incorrect statements regarding the status of Applicants’ pending claims, which was clearly used as a basis for making the Office action final, **amounts to clear error.**

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the cited art fails to teach or suggest all aspects of independent claims 22, 38, 58, 65, 82, and 102, and their respective dependent claims, that the Office fails to establish a *prima facie* case of obvious with respect to those claims or the claims that depend therefrom, and that the respective rejections under 35 USC §103(a) cannot be maintained. Thus, Applicants respectfully submit that pending claims 22, 23, 25-39, 41-66, 68-83, 85-103, and 105-122 should be in condition for allowance and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: November 11, 2010
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